

Serial No. 10/690,731

Amend. in Resp. to Off Act. of Dec. 16, 2004

UTILITY PATENT

B&D No. TN1488A

REMARKS

Applicants have amended Claim 25. Claims 25-29 therefore are pending in the present application.

The Examiner objected to the abstract "because the statement of the technical disclosure in the abstract does not reflect the limitations of the claims." Such objection is respectfully traversed.

Under 37 CFR § 1.72, the abstract need only to "enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure." *See also* MPEP § 608.01(b)(A). In other words, there is no requirement that the abstract reflect the limitations of the claims, just that it provides a summary of the technical disclosure, i.e., the specification.

In the present case, the abstract accurately reflects a technical aspect described in the specification. Accordingly, the MPEP and CFR requirements have been met. Therefore, the abstract does not need to be amended.

The Examiner also objected to Claims 25 and 28. In particular, the Examiner requested that the phrase "rotatably table" in Claim 25 be amended to ~~table~~. Applicants have amended Claim 25 accordingly.

The Examiner also requested that the phrase "a workpiece" in Claim 28 be amended to ~~the workpiece~~. Applicants decline to amend Claim 28 as suggested by the Examiner as, if such amendment were made, no proper antecedent basis would exist for ~~the workpiece~~.

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The Examiner rejected Claims 25-29 under 35 USC § 112, second paragraph, as being indefinite. In particular, the Examiner objected to the use of the word "about" as it made the angle range unclear. Reconsideration and withdrawal of such rejection is respectfully requested.

Applicants submit that the PTO has found the word "about" to be clear when used with ranges. *See, e.g.*, MPEP § 2173.05(b)(A) ("The term 'about' used to define [an area range] as between 25 to about 45% ... was held to be clear.") (*citing W.L. Gore & Assocs., Inc. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *Ex parte Eastwood*, 163 USPQ 316 (Bd. App. 1968)). Because the term "about" has been held to be clear, the claimed elements are clear as well. Accordingly, Claims 25-29 satisfy the requirements of 35 USC § 112, second paragraph.

The Examiner rejected Claims 25-27 under 35 USC § 103(a) as being unpatentable over Applicants' admitted prior art ("APA") in pages 1-2 of the present application in view of US Patent No. 4,075,916 ("Fisher"). In addition, the Examiner rejected Claims 28-29 under 35 USC § 103(a) as being unpatentable over APA and Fisher in view of US Patent No. 3,651,840 ("Ridenour").

Claim 25, as amended, calls for a miter saw comprising a base assembly, a table rotatably connected to the base assembly for rotating about a miter axis, the table having a plane, a saw assembly including a motor, a blade driven by the motor and disposed on an arbor, and an upper blade guard covering an upper part of the blade and the arbor, said saw assembly being pivotable from an upper position away from the table to a lower position towards the table, and a pivot arm pivotally attached to the table so that the saw assembly can be beveled about a bevel axis leftwardly and rightwardly from a position where the blade is substantially perpendicular to the

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table plane, a first fence assembly attached to the base at one side of the blade, a second fence assembly attached to the base at the other side of the blade, wherein the motor has a longitudinal axis which is substantially perpendicular to longitudinal axis of the arbor, the motor longitudinal axis being at an angle relative to the miter axis, the angle being between about 47° and about -90°. Claims 26-29 are ultimately dependent upon Claim 25.

As admitted by the Examiner, the APA does not disclose the motor having a longitudinal axis perpendicular to the arbor, or that such axis is at an angle relative to the miter axis, the angle being between about 47° and about -90°. Assuming for the sake of argument that Fisher discloses such elements and that a suggestion or motivation exists to combine the APA with Fisher, the resulting device would not have all the elements of Claim 25.

This is because neither the APA nor Fisher disclose a double-bevel miter saw, i.e., one where the saw assembly moves leftwardly and rightwardly from a substantially vertical position. Instead, the APA described in pages 1-2 of the specification and shown in FIGS. 1-2 of the application discloses a miter saw that only moves leftwardly from a substantially vertical position.

By contradistinction, Claim 25 requires "a pivot arm pivotally attached to the table so that the saw assembly can be beveled about a bevel axis leftwardly and rightwardly from a position where the blade is substantially perpendicular to the table plane." Because neither the APA nor Fisher show such element, the resulting combination cannot render Claim 25 and its dependent claims unpatentable.

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Furthermore, Ridenour does not disclose such missing element either. Accordingly, the APA/Fisher/Ridenour combination cannot render Claims 28-29 unpatentable, assuming for the sake of argument that all references can be properly combined under the present law.

Applicants believe the application to be in condition for formal allowance. Accordingly, allowance of Claims 25-29 is respectfully requested.

The Commissioner is authorized to charge payment of a two-month extension (\$450.00), as well as any other fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

Respectfully submitted,



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